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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,709	01/17/2002	Eiichi Hatakeyama	32307-177799	6076

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EXAMINER

CHARLES, DEBRA F

ART UNIT

PAPER NUMBER

3691

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/046,709

Applicant(s)

HATAKEYAMA, EIICHI

Examiner

Debra F. Charles

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>January 6, 2003</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Objections

1. Claim 19 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claims 15 and 17. See MPEP § 608.01(n). Accordingly, the claim 19 not been further treated on the merits.

Response to Amendment

1. Claim 14 has been amended.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1,2,3,9,10,15,17,19,20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin(US 6330547 B1) and Risen, Jr. et al.(US 6018714 A) .

Re claims 1,15, 19,20: Martin discloses method of investment management for managing an investment to a business to be performed by an entrepreneur using an intellectual property right, comprising the steps of: storing information about a beneficiary right in a first server computer, wherein the beneficiary right is based on the intellectual property right transferred from the entrepreneur to a fund donor in exchange for funds

to be provided to the business and supplied by the fund donor(col. 2 and 3).

Martin fails to teach and performing an income estimation about the investment to the entrepreneur at the first server computer on the basis of the information about the beneficiary right stored in the first server computer and information about proceeds of the business of the entrepreneur received from a first client computer(col. 1 and 2, Table 1).

However, Risen, Jr. et al. does teach valuing the intellectual property and keeping track of that value over the life of the property(col. 1 and 2, Table 1). Therefore, it would have been obvious to one of ordinary skill in the art the time the Applicant's invention was made to modify the teachings of Martin to include the step of Risen, Jr. et al. The motivation to combine these references is to efficiently and effectively determine the value of one intellectual property asset and provide funding bases on that value.

Re claim 2: Martin fails to teach royalties or licenses granted to person doing the funding. However, Risen, Jr. et al. does teach the beneficiary right includes a right to receive a royalty(col. 22, lines 34-42) from the entrepreneur under a license(col. 8, lines 50-65) being granted to the entrepreneur on the basis of the intellectual property right being transferred to the fund donor. Therefore, it would have been obvious to one of ordinary skill in the art the time the Applicant's invention was made to modify the teachings of Martin to include the step of Risen, Jr. et al. The motivation to combine these references is to efficiently and effectively determine the value of one intellectual property asset and provide funding bases on that value.

Re claim 3: Martin discloses notifying to the first client computer that processes the information about the entrepreneur before the intellectual property right is transferred from the entrepreneur to the fund donor, wherein the notifying step including the steps of: the first server computer receives an application for financing to the business of the entrepreneur from the first client computer(Abstract, col. 4, lines 25-67), and

the first server computer transmits notice information chosen from two or more notice information for notifying a corresponding examination result about the application to the first client computer, wherein the two or more

notice information for notifying the respective examination results is previously stored in the first server computer(Col. 5, lines 1-43, Fig. 4, col. 8, lines 5-67, i.e. score received by asset indicates examination results).

Re claims 9, 17, 22: Martin discloses storing sales information about a financial product in a second server computer that processes information about a financial institution that supplies the financial product that is made from the beneficiary right transferred from the fund donor by means of processes of liquidating and securitizing an asset(col. 11, lines 1-col. 12, line 67, col. 15,lines 25-65); and

transmitting the sales information stored in the second server computer to a second client computer that processes information about an investor(Fig. 2 showing several different CPUs for processing).

Re claim 10: Martin discloses receiving information on purchase application from the second client computer by the second server computer, wherein the purchase application is provided for the purchase of a financial product represented by the sales information transmitted from the second client computer to the second server computer(col. 2,lines 34-67, i.e. a loan is a financial product); and

transmitting reply that corresponds to the purchase application provided for the purchase of the financial product from the second server computer to the second client computer, wherein the reply is chosen from a plurality of reply information by the financial institute, wherein the plurality of reply information is previously stored in the second server computer for the purchase application(col. 14, lines 5-15, report provided to lender is a reply).

3. Claims 4, 5, 6,7, 8,12,13, 14,16,18, 21, and 23 are rejected under 35

U.S.C. 103(a) as being unpatentable over Martin and Risen Jr. et al. as

applied to claim 1 above, and further in view of Wilkinson et al.(US

2002/0099637 A1).

Re claims 4 and 5: Both Martin and Risen Jr. et al. fail to teach wherein the information about the proceeds of business includes information about an income to be brought from the entrepreneur. However, Wilkinson et al. does teach income(para 0010-0015 and 0078). Therefore, it would have been obvious to one of ordinary skill in the art the time the Applicant's invention was made to modify the teachings of Martin and Risen Jr. et al. to include the step of Wilkinson et al. The motivation to combine these references is to illustrate the income from the entrepreneur via the IP asset.

Re claims 6, 8 and 13: Both Martin and Risen Jr. et al. fail to teach the intellectual property right transferred from the entrepreneur to the fund donor is a target property of trust with the fund donor; and the information about the beneficiary right includes information about a fund that is established by the fund donor with respect to the beneficiary right on the basis of the intellectual property right transferred from the entrepreneur to the fund donor; beneficiary right transferred from the fund donor is an investment target property for pension fund management by the financial institution. However, Wilkinson et al. does teach funds used to finance a portfolio from the IP income and mutual funds that own the IP asset(para 0006, mutual fund, portfolios of pension fund or mutual fund, para 0010-0015, 0118-0141). Therefore, it would have been obvious to one of ordinary skill in the art the time the Applicant's invention was made to modify the teachings of Martin and Risen Jr. et al. to include the step of Wilkinson et al. The motivation to combine these references is to illustrate the income from the entrepreneur via the IP asset.

Re claim 7: Both Martin and Risen Jr. et al. fail to teach first server computer takes charge of an income obtained by means of the beneficiary right as reinvestment capital funds for another business to circulate the income. However, Wilkinson et al. does teach investing fund derived from the IP assets(para 0118-0141, 0146-0147, Fig. 2, Investment Management box). Therefore, it would have been obvious to one of ordinary skill in the art the time the Applicant's invention was made to modify the teachings of Martin and Risen Jr. et al. to include the step of Wilkinson et al. The motivation to combine these references is to illustrate the income from the entrepreneur via the IP asset.

Re claims 12, 14,16,18, 21, 23: Both Martin and Risen Jr. et al. fail to teach the beneficiary right is consolidated investment beneficiary right that further includes a beneficiary right on the basis of securities with stock instrument included issued by the entrepreneur; and the financial product is a fixed interest security. However, Wilkinson et al. does teach stock and bond issues based on the IP asset (para 0021-0042). Therefore, it would have been obvious to one of ordinary skill in the art the time the Applicant's invention was made to modify the teachings of Martin and Risen Jr. et al. to include the step of Wilkinson et al. The motivation to combine these references is to illustrate the income from the entrepreneur via the IP asset.

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin and Risen Jr. et al. as applied to claim 9 above, and further in view of Elliott(US 2001/0042034 A1).

As per claim 11: Both Martin and Risen Jr. et al. fail to disclose the beneficiary right transferred from the fund donors a priority beneficiary right. However, Elliott discloses he intellectual property portfolio may even contain intellectual properties owned by third parties, so long as the owner seeking securitization has exclusive rights in such third party intellectual properties, and the right to convey such exclusive rights to others. Once an intellectual property portfolio is specifically identified, for the purposes of the method, the portfolio, and each component thereof, is given an identifier for tracking purposes(para 0031). Therefore, it would have been


obvious to one of ordinary skill in the art the time the Applicant's invention was made to modify the teachings of Martin and Risen Jr. et al. to include the step of Elliott The motivation to combine these references is to illustrate the income from the entrepreneur via the IP asset.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra F. Charles whose telephone number is (571) 272 6791. The examiner can normally be reached on 9-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander G. Kalinowski can be reached on (571) 272 6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Debra F. Charles
Examiner
Art Unit 3691



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